

### **REMARKS**

Claims 12, 27, 28, 30, and 33-37 are pending in the application.

#### **Rejections under 35 U.S.C. § 101/112**

Claims 12, 27-28, 30 and 33-37 are rejected under 35 USC § 101 for the reasons of record in the April 13, 2005 Office Action. Examiner states that the previous arguments by Applicant were unpersuasive.

Applicants traverse this rejection as the specification provides a specific assertion of the utility for the claimed nucleic acids.

The as-filed specification discloses that these claimed nucleic acids are useful in differentiating certain tissues types. Specifically, the as-filed specification demonstrates that the claimed IL-1L1 nucleic acid is highly expressed in placenta. (See, Figure 7) Thus, the nucleic acids of the claimed invention are useful as tissue specific markers by detecting the level of expression of these specific nucleic acids in a biological sample, *e.g.*, in a tissue sample from a subject. Thus, the utility of the claimed nucleic acid molecules is specific, rather than “generally applicable to broad classes” of nucleic acids.

The skilled artisan would appreciate that measurement of the relative amount of nucleic acid in a tissue, is useful as a real-world tool in such areas as histology and pathology. Such expression tests are currently commercially available in the U.S., thereby demonstrating a substantial and credible “real world” utility for an invention of this type. For example, high molecular weight cytokeratin (HMW CK) is routinely used to identify basal cells, p63 is routinely used as a nuclear marker and cytokeratin 18 (CK18) is routinely used to identify epithelial cells in a variety of tissue types .

Applicants submit, therefore, that the as-filed specification provides a specific, substantial and credible utility for the claimed nucleic acids as tissue specific markers, *e.g.*, in histological tests. Accordingly, the claim rejections under 35 U.S.C. § 101 should be withdrawn.

### CONCLUSION

Applicants submit that the application is in condition for allowance and such action is respectfully requested. Should any questions or issues arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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